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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/456,184 12/07/99 OKADA

H 15162/01320

EXAMINER

MM92/0202

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717 NORTH HARWOOD
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DAUGHERTY, T PAPER NUMBER

2834
DATE MAILED:

02/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/456,184

Applicant(s)
Okada

Examiner
Thomas M. Dougherty

Group Art Unit
2834

☒ Responsive to communication(s) filed on Jan 23, 2001

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-26 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-26 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Response to Arguments

1. Applicant's arguments concerning the restriction requirement filed 1/23/01 have been fully considered and they have resulted in a re-evaluation of the restriction requirement. While the arguments include the statement that "The classification set forth in the Office Action for claims 12-16, i.e., class 310 subclass 316.03, is in error" based on the headings used to describe that subclass, these claims are a best fit for that subclass. The re-evaluation has resulted in however, regrettably, an oversight by the Office. The original election/restriction more properly contains three groups of claims not the two groups of the original restriction requirement. Therefore the original election/restriction requirement is hereby withdrawn in favor of the election/restriction requirement enumerated below.

Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-6 and 17-26, drawn to A DRIVING CIRCUIT OR METHOD FOR A PIEZOELECTRIC ACTUATOR, classified in class 310, subclass 317.
 - II. Claims 7-11, drawn to A PIEZOELECTRIC ACTUATOR, classified in class 310, subclass 323.17.

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III. Claims 12-16, drawn to A DISCHARGING CIRCUIT FOR A PIEZOELECTRIC DEVICE, classified in class 310, subclass 316.03.

3. Inventions of Group I and of Group II are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the actuator can be driven by another drive circuit. The subcombination has separate utility such as a drive circuit for a magnetostrictive or electro-magnetic device.

4. The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and of Group II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of Group I has separate utility such as a motor component, alternatively the invention of Group II has separate utility as a valve discharge circuit. See MPEP § 806.05(d).

5. Inventions of Group II and of Group III are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as

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claimed because the actuator can be driven by another drive circuit. The subcombination has separate utility such as a drive circuit for a magnetostrictive or electro-magnetic device.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. Because these inventions are distinct for the reasons given above and the search required for any of the groups is not required for any other of the groups, restriction for examination purposes as indicated is proper.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas M. Dougherty whose telephone number is (703) 308-1628.

TMD
TMD

February 2, 2001

Thomas M. Dougherty
THOMAS M. DOUGHERTY
PRIMARY EXAMINER
GROUP 2100
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